

R E M A R K S

Reconsideration of the application in view of the above amendments and following remarks is respectfully requested. Claims 1, 8, 15, 25, 35 and 41 have been amended. Therefore, claims 1-45 are pending in the application.

Supplemental Information Disclosure Statement

Enclosed herewith is a Supplemental Information Disclosure Statement (IDS). Applicant respectfully requests that the Examiner consider, initial, and return a copy of the PTO/SB/08A and PTO/SB/08B to Applicant.

Double Patenting Claim Rejections

The Examiner rejected claims 1-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,763,195 to Willebrand et al. (the parent application hereto). Applicants respectfully traverse these rejections.

Applicants request that this rejection be held in abeyance until the rejections under 35 U.S.C. 103 have been overcome so that the final form of the claims can be considered with respect to this rejection.

Claim Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-5, 7, 8, 10-12, 14, 15, 22, 24, 25, 32, 34, 40, 41 and 45 under 35 U.S.C. § 103(a) as being unpatentable over German Patent No. DE 4433896 C1 to Vollert ("Vollert") in view of U.S. Patent No. 4,904,993 to Sato ("Sato"). Applicants respectfully traverse these rejections.

Applicants have amended claim 1 in a manner that overcomes the rejection. Specifically, claim 1 has been

amended to recite "wherein an RF transceiver for generating the RF signal is active during the active mode". This amendment is clearly supported by Applicants' specification at, for example, page 12, lines 12-16, which discloses that the RF path 28 is active in both the active and standby modes. Independent claims 8, 15, 25, 35 and 41 have been amended in a similar manner.

Because amended claim 1 now specifies that the RF transceiver is active during the active mode, the RF transceiver is active at the same time that data is being transmitted in the optical signal in the active mode. This is quite different than the systems disclosed in Vollert and Sato.

Vollert:

Vollert teaches directly against having his radio transmitters be active while information is being exchanged over his infrared transmission path. Specifically, Vollert discloses a method and communication system for reducing the radio transmissions in wireless communication systems. (See Vollert's title: "Method and communication system for reducing the radio transmissions in wireless communication systems"). Vollert teaches that the purpose of such RF reduction is to both reduce potential adverse effects on users from the RF transmissions and to reduce overall power consumption. For example, Vollert states:

"A portion of the users of pico-cellular wireless communication systems fear negative effects on the user of the radio signals in the microwave range that are given off by the transmitters during radio connections." (Vollert, English-language translation, page 2, ¶ 2).

To achieve these purposes, Vollert teaches the use of an infrared (IR) transmission path so that when information is

exchanged over the IR transmission path, at least the radio transmitters that implement the radio transmission path are deactivated. In this regard Vollert states:

"As a result, radio transmissions in a wireless communications system are reduced substantially and possible effects on the user caused by radio signals are avoided and average power consumption is reduced." (Vollert, English-language translation, Abstract, last sentence).

Applicants submit that Vollert actually teaches against Applicants' claimed step of having the RF transceiver be active during the active mode when the data is being transmitted in the optical signal. Vollert teaches away from this step because having the RF transceiver be active at the same time data is being transmitted in the optical signal would completely defeat Vollert's purpose of reducing RF transmissions in order to reduce potential adverse effects on users. In other words, Applicants' amended claim 1 encourages the use of an RF path, whereas Vollert discourages the use of the RF path.

Section 2143.01 of the MPEP states:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." (MPEP § 2143.01 Suggestion or Motivation To Modify the References).

Modifying Vollert's system to make his radio transmitters be active at the same time that information is exchanged over his IR transmission path would render Vollert's system unsatisfactory for its intended purpose of substantially reducing radio transmissions. This is because with this modification Vollert's radio transmitters would be active most

or all of the time, thus not reducing radio transmissions at all. Therefore, a person of ordinary skill in the art would not find a reason to make such modification, which means that a *prima facie* case of obviousness of Applicants' amended independent claim 1, as well as amended independent claims 8, 15, 25, 35 and 41, cannot be established using Vollert.

Sato:

Sato also teaches directly against having his radio signal sending circuit 12 be active while information is being sent over his optical signal sending circuit 14. Specifically, Sato's switch 17 shown in his figure can only be connected to either the radio signal sending circuit 12 or the optical signal sending circuit 14, but not both. This is supported by Sato's statement that:

"Moreover, data is output from a data generating circuit 16 through operation of a data selection circuit 15 and this data is switched by a switch 17 and is then given to any one of the radio signal sending circuit 12 or optical signal sending circuit 14." (Sato, col. 2, lines 30-34) (emphasis added).

Furthermore, Sato teaches that a power supply voltage is supplied to only one of the radio signal sending circuit 12 or the optical signal sending circuit 14. Specifically, Sato states:

"In conjunction with switching operation of the switch 17, a power supply voltage is supplied to any one of the radio signal sending circuit 12 or optical signal sending circuit 14 by another switch 18 in order to operate such circuit. The selection means is formed by these switches 17 and 18." (Sato, col. 2, lines 34-39) (emphasis added).

These teachings by Sato indicate that his radio signal sending circuit 12 cannot be active while information is being sent over his optical signal sending circuit 14, which means Sato

does not disclose Applicants' amended claim 1.

Furthermore, a person of ordinary skill in the art would not find a reason to modify Sato to make the radio signal sending circuit 12 and optical signal sending circuit 14 active at the same time because such modification would substantially change Sato's principal of operation. As such, a *prima facie* case of obviousness of Applicants' amended independent claims 1, 8, 15, 25, 35 and 41, cannot be established using Sato.

Sato does not disclose automatic switching:

In addition to the above reasons why the rejections of Applicants' claims should be withdrawn, Applicants also respectfully disagree with the Examiner's analysis of Sato. Specifically, the Examiner asserts that Sato teaches automatically switching from the active mode to a standby mode upon optical beam degradation in the terrestrial free-space region. (Office Action mailed 2/9/05, page 5, lines 3-7). However, Sato simply does not teach any such automatic switching. This is because there is simply nothing shown or described in Sato that makes the switches 17 and 18 operate automatically. The Examiner cites Sato's FIG. 1 and column 2, lines 25-40 as disclosing such automatic switching. But the cited language simply does not disclose that the switches 17 and 18 operate automatically, and there is nothing shown in FIG. 1 that could possibly cause the switches 17 and 18 to operate automatically.

In fact, Applicants submit that a reading of Sato as a whole indicates that the switches 17 and 18 are switched manually by the user. For example, Sato states the following:

"when a user provided said the transmitter is within unimpeded visual range of a location where said receiver is installed, the user can switch over said switching means to transmit an optical signal to said receiver in

order to save consumption of power from said battery power source." (Sato, col. 4, lines 31-36) (emphasis added).

This language clearly indicates that it is the user who manually switches the switches 17 and 18.

Therefore, Sato does not disclose Applicants' claimed step of "automatically switching" as alleged by the Examiner, which is another reason why a *prima facie* case of obviousness of Applicants' claims has not been established.

For all of the above reasons, the rejections of amended independent claims 1, 8, 15, 25, 35 and 41 should be withdrawn. Furthermore, the rejections of the claims that depend from these claims should also be withdrawn for at least these same reasons.

Fees Believed to be Due

No extra claims fees are believed to be due. A fee for the Information Disclosure may be charged to deposit account number 06-1135 to Fitch, Even, Tabin & Flannery.

C O N C L U S I O N

Should there be any outstanding issues that require adverse action with respect to this amendment, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858)552-1311 so that such issues may be resolved as expeditiously as possible.

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Amendment

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Respectfully submitted,



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